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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,702	12/17/2003	Thomas Grafenauer	P27102	5695

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EXAMINER	
CAJILIG, CHRISTINE T	

ART UNIT	PAPER NUMBER
3633	

NOTIFICATION DATE	DELIVERY MODE
07/10/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/736,702	GRAFENAUER, THOMAS	
	Examiner	Art Unit	
	CHRISTINE T. CAJILIG	3633	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 June 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-10,12-20 and 24-27* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-10,12-15,17,18,20 and 24-27* is/are rejected.

7)☒ Claim(s) *16 and 19* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *17 December 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/06/08 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 8, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eisermann (U.S. Patent No. 6,804,926 B1) in view of Schwitte et al. (U.S. Publication No. 2003/0037504 A1).

Regarding claim 1, Eisermann discloses a building board made of fiberboard which can be laid on beams, which are spaced apart parallel to one another, in order to form a subfloor in a residential or commercial building and which has two mutually opposite longitudinal edges and two mutually opposite transverse edges running at right angles to the longitudinal edges, one longitudinal edge and one transverse edge in each

case having a tongue (6) and the opposite longitudinal edge and transverse edge having a groove (20) corresponding to the tongue (the board of Eisermann having the similar complementary tongue and groove connection for all four edges); via which a plurality of building boards can be connected to one another and locked in the vertical direction in relation to one another, wherein the tongue on the longitudinal edge comprises a bevel (12) and a recess (b) adjacent the bevel, wherein the bevel transitions into a flat surface (11) of the recess, and the tongue and the groove on the longitudinal edge are designed such that two boards which are connected to one another at the longitudinal edges are also locked in a horizontal direction in relation to one another (Col 6, Ln 21-27), wherein the groove on the longitudinal edge is bounded by a top lip (22) and a bottom lip (21), the bottom lip projects laterally beyond the top lip and has a concave recess over the entire length, and the tongue has a convex underside which corresponds to the concave recess, and the bevel is flat or planar and is conterminous with the convex underside of the tongue, the recess is defined by the flat surface and another flat surface formed in the tongue, and in an assembled state, an edge of the top lip of a first said building board bounds the recess of a second said building board forming a closed space.

Eisermann does not disclose that the building board is board made of OSB (oriented strand board) nor discloses that the recess is defined by a curved surface formed in the tongue.

Schwitte et al. discloses a floorboard having a recess (9) in the tongue, wherein the recess is defined by a flat surface (8a) and a curved surface to provide a pocket for excess glue.

All of the claimed elements were known in the prior art and one skilled in the art could have modified the recess of Eisermann to have a curved surface as taught by Schwitte et al. by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

Moreover, it would have been obvious to one having ordinary skill in the art at the time of invention to use OSB, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice thus providing a durable, strong material. *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). Furthermore, OSB has been old and well known in the building industry as a material commonly used for building and flooring products. See Par 0005 in previously cited publication to Palsson (2003/0079820 A1) which lists common prefabricated floor board materials.

Regarding claim 8, Eisermann discloses a building board, comprising a first longitudinal edge having a tongue (6); a second longitudinal edge opposite the first longitudinal edge and having a groove (20) bounded by a top lip (22) and a bottom lip (21); a first transverse edge adjacent to the first and second longitudinal edges and having a tongue (6); a second transverse edge adjacent to the first and second longitudinal edges and having a groove (21; the board of Eisermann having similar

complementary tongue and groove connection for all four edges); and an upwardly projecting extension (a) on the bottom lip of the second longitudinal edge that locks interconnected boards in a horizontal direction in relation to one another (Col 6, Ln 21-27), wherein a front edge of the tongue of the first longitudinal edge comprises a bevel (12), and a recess (b) formed in the tongue adjacent the bevel, the recess being defined by a flat surface and another flat surface formed in the tongue, the bevel is flat or planar, the bottom lip of the second longitudinal edge has a concave recess (23) over its length, and the tongue of the first longitudinal edge has a convex underside (7) which corresponds to the concave recess, the bevel being conterminous with the flat surface of the recess and the convex underside of the tongue, wherein the building board is made of fiberboard and in an assembled state, a portion of the top lip of a first said building board is located within the recess of a second said building board.

Eisermann does not disclose that the building board is board made of OSB (oriented strand board) nor discloses that the recess is defined by a curved surface formed in the tongue.

Schwitte et al. discloses a floorboard having a recess (9) in the tongue, wherein the recess is defined by a flat surface (8a) and a curved surface to provide a pocket for excess glue.

All of the claimed elements were known in the prior art and one skilled in the art could have modified the recess of Eisermann to have a curved surface as taught by Schwitte et al. by known methods with no change in their respective functions, and the

combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

Moreover, it would have been obvious to one having ordinary skill in the art at the time of invention to use OSB, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice thus providing a durable, strong material. *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). Furthermore, OSB has been old and well known in the building industry as a material commonly used for building and flooring products. See Par 0005 in previously cited publication to Palsson (2003/0079820 A1) which lists common prefabricated floor board materials.

Regarding claim 25, Eisermann already modified by Schwitte et al. further discloses that the flat surface of the recess is substantially horizontal in an assembled state.

Claims 3, 6, 9, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eisermann in view of Schwitte et al. as applied to claims 1 and 8 above, and further in view of Thiers (US 2002/0056245 A1).

Regarding claim 3, Eisermann already modified by Schwitte et al. discloses the structure as discussed above, but does not disclose that the longitudinal edges and the transverse edges have a chamfer on their top side, with the result that a V-shaped joint is formed at the connecting location between two boards.

However, Thiers discloses a floor board (2) wherein the longitudinal edges and the transverse edges have a chamfer (15, Par 0066) on their top side, with the result that a V-shaped joint is formed at the connecting location between two boards as shown in Figure 5.

Therefore, it would have been obvious to one having ordinary skill in the arts at the time of the Applicant's invention to modify the floor board of Eisermann already modified by Schwitte et al. so that the longitudinal edges and the transverse edges have a chamfer on their top side, with the result that a V-shaped joint is formed at the connecting location between two board as taught by Theirs to provide a panel that can be easily rotated in relation to one another (Par 0067) as well as provide an aesthetically pleasing surface along the upper edges of the board.

Regarding claim 6, Eisermann already modified by Schwitte et al. discloses the structure as discussed above, but does not disclose a layer on the top side of the board that is provided with markings along which the board is capable of being fastened on the beams by means of screws or nails.

However, Thiers discloses a floor board (2) wherein the top decorative layer (23) has markings in the form of imprinted wood patterns, along which, screws or nails could obviously be fastened.

Therefore, it would have been obvious to one having ordinary skill in the arts at the time of the Applicant's invention to modify the floor board of Eisermann already modified by Schwitte et al. to have markings on the decorative, along which, screws or

nails could obviously be fastened as taught by Theirs to provide a decorative surface that replicates wood.

Regarding claims 9 and 10, Eisermann already modified by Schwitte et al. discloses the structure discussed above, but does not disclose a first chamfer on a top side of the top lip of the second longitudinal edge and a second chamfer disposed above the tongue of the first longitudinal edge, resulting in a V-shaped joint formed by connecting boards.

However, Thiers discloses a floor board (2) wherein the first and second longitudinal edges have a first and second chamfer (15, Par 0066), respectively, on their top side, with the result that a V-shaped joint is formed at the connecting location between two boards as shown in Figure 5.

Therefore, it would have been obvious to one having ordinary skill in the arts at the time of the Applicant's invention to modify the floor board of Eisermann already modified by Schwitte et al. to have a first chamfer on a top side of the top lip of the second longitudinal edge and a second chamfer disposed above the tongue of the first longitudinal edge, resulting in a V-shaped joint formed by connecting boards as taught by Theirs to provide a panel that can be easily rotated in relation to one another (Par 0067) as well as provide an aesthetically pleasing surface along the upper edges of the board.

Claims 4, 5, 15, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eisermann in view of Schwitte et al. as applied to claims 1 and 8 above, and further in view of Kornicer et al. (US 2003/0035921 A1).

Regarding claims 4, 5, 15, and 17, Eisermann already modified by Schwitte et al. discloses the floor board above, but does not disclose that the board comprises four layers, in which case, in the two outer layers, a longitudinal direction of strands is oriented predominantly in the longitudinal direction of the board, and in the two inner layers, a longitudinal direction of other strands is oriented predominantly in the transverse direction of the board or that the board comprises strands glued with an isocyanate resin.

However, Kornicer et al. discloses a multi-layered oriented strand board (10) has four layers, in which case, in the two outer layers (12, 16), a longitudinal direction of strands is oriented predominantly in the longitudinal direction of the board, and in the two inner layers (14, 15), a longitudinal direction of other strands is oriented predominantly in the transverse direction of the board as shown in Figure 1, and comprises strands glued with isocyanate resin (Par 0029-0035).

Therefore, it would have been obvious for a person having ordinary skill in the arts at the time of the Applicant's invention to modify the floor board of Eisermann already modified by Schwitte et al. to have four layers, in which case, in the two outer layers, a longitudinal direction of strands is oriented predominantly in the longitudinal direction of the board, and in the two inner layers, a longitudinal direction of other strands is oriented predominantly in the transverse direction of the board and the

strands glued with isocyanate resin as taught by Kornicer et al. to provide a material that is better suited for use as flooring in damp environments (Par 0018).

Claims 7 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eisermann in view of Schwitte et al. as applied to claims 1 and 8 above, and further in view of Hall (US 347,425).

Regarding claim 7, Eisermann already modified by Schwitte et al. discloses the floor board above, but does not disclose that the bottom lip of the groove, on the longitudinal and/or transverse side, has depressions, which are spaced apart parallel to one another, for accommodating a nail or screw head.

Hall, however, discloses a cladding wherein a bottom lip (B) of a groove comprises depressions (c), which are spaced apart parallel to one another, for accommodating a nail or screw head.

Therefore, it would have been obvious for a person having ordinary skill in the arts at the time of the Applicant's invention to modify the floor board of Eisermann already modified by Schwitte et al. to have the groove, on the longitudinal and/or transverse side, include depressions, which are spaced apart parallel to one another, for accommodating a nail or screw head as taught by Hall to have preformed holes to fix the floor board in place.

Regarding claims 12-14, Eisermann already modified by Schwitte et al. discloses the structure as discussed above and further discloses that the groove of the second transverse edge comprises a top lip and a bottom lip (all edges having the same joint

connection), but does not disclose a plurality of spaced apart recesses provided along the bottom lip of the second longitudinal edge nor that the bottom lip of the second transverse edge having a plurality of spaced apart recesses, and wherein the plurality of recesses of the second longitudinal edge and the second transverse edge are configured to accommodate countersunk nail heads or screw heads.

Hall, however, discloses a cladding wherein a bottom lip (B) of a groove comprises a plurality of spaced apart recesses(c) configured to accommodate countersunk nail heads or screw head.

Therefore, it would have been obvious for a person having ordinary skill in the arts at the time of the Applicant's invention to modify the floor board of Eisermann already modified by Schwitte et al. to have the bottom lips of each of the groove on the longitudinal and transverse side, have a plurality of spaced apart recesses configured to accommodate countersunk nail heads or screw head as taught by Hall to have preformed holes to fix the floor board in place. Furthermore, it has been held that a mere duplication of parts, such as the duplication of the recesses, has no patentable significance unless a new and unexpected result is produced. A duplication of parts is generally recognized as being within the level of ordinary skill in the art. *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1955).

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eisermann in view of Schwitte et al. as applied to claim 8 above, and in further view of Smid et al. (US 6012255).

Regarding claim 18, Eisermann already modified by Schwitte et al. discloses the floor board above, but does not disclose markings provided on a top side of the board and adapted to correspond to spacing between beams.

However, Smid et al. in Figures 2A-2F discloses building material with a plurality of marks (12) corresponding to spacing of supports on which the building material would be mounted.

Therefore, it would have been obvious for a person having ordinary skill in the arts at the time of the Applicant's invention to modify the floor board of Eisermann already modified by Schwitte et al. to include markings on a top side of the board and adapted to correspond to spacing between beams as taught by Smid et al. to provide a visual indicator for a worker of where to fasten the board (Abstract).

Claims 20 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eisermann (U.S. Patent No. 6,804,926 B1) in view of Schwitte et al. (U.S. Publication No. 2003/0037504 A1) and Hall (US 347,425).

Regarding claims 20 and 26, Eisermann discloses a building board made of fiberboard comprising two mutually opposite longitudinal edges and two mutually opposite transverse edges running at right angles to the longitudinal edges, one longitudinal edge and one transverse edge in each case having a tongue (6) and the opposite longitudinal edge and transverse edge having a groove (20) corresponding to the tongue (the board of Eisermann having the similar complementary tongue and

groove connection for all four edges); via which a plurality of building boards can be connected to one another and locked in the vertical direction in relation to one another,

wherein the groove on the longitudinal edge is bounded by a top lip (22) and a bottom lip (21), the bottom lip projects laterally beyond the top lip and has a concave recess over the entire length, the tongue has a convex underside (7) which corresponds to the concave recess, the tongue of the first longitudinal edge comprises a flat or planar bevel (12) and a recess (b) formed adjacent to the bevel, the recess being defined by a flat surface and another flat surface formed at a transition between the tongue and a vertical wall (10) extending from the tongue, the flat or planar bevel being conterminous with the flat surface of the recess and the convex underside of the tongue, and in an assembled state, a corner of the top lip of a first said building board is located within the recess of a second said building board.

Eisermann does not disclose that the building board is board made of OSB (oriented strand board), that the recess is defined by a curved surface formed in the tongue, and that the bottom lip of the longitudinal or transverse edge has a plurality of spaced apart depressions formed in the concave recess and configured to accommodate a countersunk nail head or screw head

Schwitte et al. discloses a floorboard having a recess (9) in the tongue, wherein the recess is defined by a flat surface (8a) and a curved surface to provide a pocket for excess glue.

All of the claimed elements were known in the prior art and one skilled in the art could have modified the recess of Eisermann to have a curved surface as taught by

Schwitte et al. by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

Hall, discloses a cladding wherein a bottom lip (B) of a groove comprises depressions (c), which are spaced apart parallel to one another, for accommodating a nail or screw head.

Therefore, it would have been obvious for a person having ordinary skill in the arts at the time of the Applicant's invention to modify the floor board of Eisermann to have the bottom lips of each of the groove on the longitudinal and transverse side, have a plurality of spaced apart recesses configured to accommodate countersunk nail heads or screw head as taught by Hall to have preformed holes to fix the floor board in place. Furthermore, it has been held that a mere duplication of parts, such as the duplication of the recesses, has no patentable significance unless a new and unexpected result is produced. A duplication of parts is generally recognized as being within the level of ordinary skill in the art. *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1955).

Moreover, it would have been obvious to one having ordinary skill in the art at the time of invention to use OSB, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice thus providing a durable, strong material. *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). Furthermore, OSB has been old and well known in the building industry as a material commonly used for building and

flooring products. See Par 0005 in previously cited publication to Palsson (2003/0079820 A1) which lists common prefabricated floor board materials.

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eisermann in view of Schwitte et al. as applied to claim 1 above, and in further view of Pervan (US 7,127,860 B2).

Regarding claim 24, Eisermann already modified by Schwitte et al. discloses the floor board above, but does not disclose that the tongue and the groove on the transverse edge are designed such that two boards which are connected to one another at the transverse edges are not locked in a horizontal direction in relation to one another.

However, Pervan in Figures 12a-12d discloses multiple alternatives for locking floorboards. Pervan discloses that longitudinal edges of a floorboard may lock horizontally as shown in Figure 12a, but that the short edges may or may not horizontally with each other as shown in Figures 12b and 12c respectively. Such alternative combinations allows for increased durability and ease of installation or disassembly (Col 12, Ln 16-31).

Therefore, it would have been obvious to substitute the complementary tongue and groove on the transverse edges of Eisermann with transverse edges that are not locked in a horizontal direction in relation to one another as taught in Figure 12c of Pervan because the substitution of one known element for another would have yielded predictable results to one of ordinary skill in the art at the time of the invention and such

a modification would allow for increased durability and ease of installation or disassembly.

Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eisermann in view of Schwitte et al. and Hall as applied to claim 20 above, and in further view of Pervan (US 7,127,860 B2).

Regarding claim 27, Eisermann already modified by Schwitte et al. and Hall discloses the floor board above, but does not disclose that the transverse edge is devoid of structure that locks, in a horizontal direction, two boards which are connected to one another.

However, Pervan in Figures 12a-12d discloses multiple alternatives for locking floorboards. Pervan discloses that longitudinal edges of a floorboard may lock horizontally as shown in Figure 12a, but that the short edges may or may not horizontally with each other as shown in Figures 12b and 12c respectively. Such alternative combinations allows for increased durability and ease of installation or disassembly (Col 12, Ln 16-31).

Therefore, it would have been obvious to substitute the complementary tongue and groove on the transverse edges of Eisermann with transverse edges that are devoid of structure that locks, in a horizontal direction, two boards which are connected to one another as taught in Figure 12c of Pervan because the substitution of one known element for another would have yielded predictable results to one of ordinary skill in the

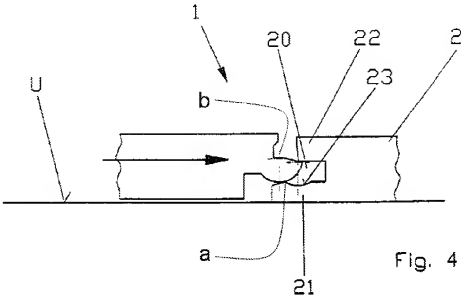
art at the time of the invention and such a modification would allow for increased durability and ease of installation or disassembly.

Allowable Subject Matter

Claims 16 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: None of the prior art alone or in obvious combination discloses a floor board having, *inter alia*, a bevel on the top lip of the second longitudinal edge which corresponds to the bevel of the tongue. To modify Eisermann with such a bevel would destroy the intended manner in which Eisermann's board would function and be assembled.

Annotated Figure



Eisermann '926

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTINE T. CAJILIG whose telephone number is (571)272-8143. The examiner can normally be reached on Monday - Thursday from 8am - 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on (571) 272-6843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. T. C./
Examiner, Art Unit 3633
6/30/08

/Brian E. Glessner/
Supervisory Patent Examiner, Art Unit 3633